

REMARKS

Reconsideration of the subject application is respectfully requested in view of the following reasons.

Upon entry of this amendment, claims 18-23 will be pending. Claims 1-3, 8 and 13-17 are deleted. Applicants reserve the right for re-entry of these claims at a later time.

In view of the cancellation of claims 1-3, 8 and 11-17, it is submitted that the outstanding rejections over McGraw et al (4,851,144) in combination with Smalheer et al, (for claims 1-3, 8, and 11-23) and over Ward et al (RE 33,658) in view of Smalheer *et al* (for claims 11-14) are no longer, if ever, relevant.

The pending claims are directed to an air compressor lubricated with a specific lubricant composition.

With regard to the rejection applied to claims 11-14, the cancellation of these claims eliminates this ground for rejection.

With regard to the 35 USC §103(a) rejection over McGraw (US 4,851,144) in combination with Smalheer *et al*, the Applicants submit that the invention as presently claimed is not obvious in light of these references. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

As Applicants previously noted, McGraw sets out to make lubricants for *refrigeration* compressors that avoid the problem of phase separation of the lubricant from a hydrofluorocarbon or hydrochlorofluorocarbon *refrigerant*.

McGraw does not relate to an air compressor and neither does Smalheer *et al*. Accordingly, the combination of these references is not considered relevant to the claimed invention.

According to McGraw, lubricants for refrigeration compressors, particularly automotive air conditioning compressors, are provided wherein a diester or polyol ester is combined with a polyether polyol lubricant composition.

In fact, McGraw, specifically differentiates between lubricants for refrigeration and lubricants for air compressors (*see*, e.g., column 1, lines 51-57, where the patentees explain that lubricants for various air compressors are not acceptable under the conditions prevalent for refrigeration).

and
air
conditioning
how
does
it
differ
from
air
compressors?

In the case of McGraw, the lubricants are used in combination with a refrigerant (*see*, column 4, lines 3-20, for exemplary refrigerants, namely, hydrochlorofluorocarbons and hydrofluorocarbons). The particular problem addressed by McGraw, as noted in column 1, lines 29-32, is the phase separation of the lubricant from the refrigerant, with the consequent damage resulting from such separation.

As will be readily appreciated, an air compressor does not require a refrigerant and, therefore, the practitioner would not be motivated to turn to the refrigerant lubricant art for solving problems involving lubricants for air compressors, especially the art relating to lubricants designed to avoid phase separation with refrigerants, a problem not relevant to the air compressor art. Again, this is confirmed by the discussion in column 1, lines 51-57, mentioned above.

The disclosure of lubricant additives by Smalheer *et al* does not change the lack of relevance of McGraw. Indeed, as explained near the bottom of the left column on page 1 of Smalheer *et al*, “[t]he bulk of all additive production finds its way into crankcase, automotive transmission, and rear axle lubricants for automotive vehicles.” Other applications for additives include steam turbines, gas turbines, jet aircraft turbines, railroad and marine diesel engines, aircraft piston engines, stationary piston engines, and relatively low power two-cycle engines. Other uses mentioned include hydraulic oils, industrial gear lubricants, and cutting oils.

Therefore, one skilled in the art would understand that additives for lubricant compositions are highly specific to the end use application.

Accordingly, while Applicants maintain that the specific lubricant composition, as claimed, would not have been obvious, nevertheless, it is respectfully submitted that irrespective of any similarities between the lubricant compositions of McGraw and the lubricant compositions of the present invention, it would not have been *prima facie* obvious to use the refrigerant lubricants of McGraw for lubricating an air compressor.

CONCLUSION

For these reasons, it is respectfully submitted that the pending claims 18-23 are patentable over the prior art. The Examiner is kindly requested to reconsider and withdraw the rejection of the claims. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: Richard A. Steinberg
Richard A. Steinberg
Registration No. 26,588
Direct No. (703) 905-2039

Paul L. Sharer
Registration No. 36,004
Direct No. (703) 905-2039

RAS/
P.O. Box 10500
McLean, VA 22102
(703) 905-2000 Telephone
(703) 905-2500 Facsimile

Attorney Reference: 090128/0280189